



*IFW/ATF*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Mark L. Yoseloff, et al. Examiner: Benjamin H. Layno  
Serial No. 10/658,863 Group Art Unit: 3711  
Filed: September 9, 2003 Docket No. PA0906.ap.US  
Title: BET WITHDRAWAL GAME WITH CARD POKER SIDE BET

**MAIL STOP APPEAL BRIEF - PATENTS**


Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**The following documents are hereby submitted:**

- ☒ Appeal Brief to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office (three copies)
- ☒ Authorization to withdraw \$250.00 to cover Appeal Brief Fee of a small entity
- ☒ Transmittal Sheet
- ☒ Return postcard

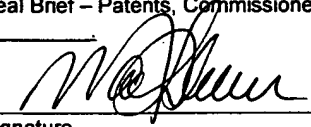
**Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers if an additional extension of time is deemed necessary by the Office. Authorization is hereby given to charge Deposit Account Number 50-1391 if such additional extension is necessary.**

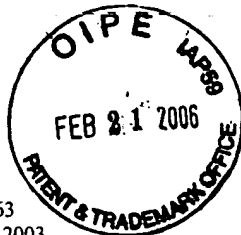
**MARK A. LITMAN & ASSOCIATES, P.A.**  
York Business Center, Suite 205, 3209 W. 76<sup>th</sup> St.  
Edina, MN 55435 (952-832-9090)

By:   
Atty: Mark A. Litman  
Reg. No. 26,390

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on 16 February 2006.

Mark A. Litman  
Name

  
Signature



BRIEF ON APPEAL  
Serial Number: 10/ 658,863  
Filing Date: September 9, 2003  
Title: BET WITHDRAWAL GAME WITH CARD POKER SIDE BET

Page 1 of 31

Docket No.: PA0906.ap.US

S/N 10/658,863

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant:	Mark L. Yoseloff, et al.	Examiner:	Benjamin H. Layno
Serial No.	10/658,863	Group Art Unit:	3711
Filed:	September 9, 2003	Docket No.	PA0906.ap.US
Title:	BET WITHDRAWAL GAME WITH CARD POKER SIDE BET		

**MAIL STOP: APPEAL BRIEF - PATENTS**

P.O. BOX 1450  
Commissioner for Patents  
Alexandria, VA22313-1450

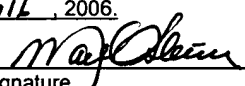
Sir:

Enclosed are three copies of this Brief On Appeal. Appellant requests personal appearance before the Board, but is delaying payment of the fee until after receiving the Examiner's Answer in accordance with 37 CFR 1.41.

The U.S. Patent and Trademark Office is hereby authorized to debit any costs and fees associated with this Petition to Deposit Account No. 50-1391.

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: MAIL STOP: APPEAL BRIEF - PATENTS, P.O. BOX 1450, Commissioner for Patents, Alexandria, VA 22313-1450 February 16, 2006.

Mark A. Litman  
Name

  
Signature

02/22/2006 MAHED1 00000024 501391 10658863

01 FC:2402 250.00 DA

**TABLE OF CONTENTS**

<b>Topic</b>	<b>Page</b>
1. Real party in interest page(s).....	3
2. Related appeals and interferences page(s).....	4
3. Status of claims page(s).....	5
4. Status of amendments page(s).....	6
5. Summary of claimed subject matter page(s).....	7
6. Grounds of rejection to be reviewed on appeal page(s).....	8
7. Argument page(s).....	9-22
8. Conclusion.....	28
9. Claims appendix page(s).....	24-27
10. Evidence appendix page(s).....	29
11. Related proceedings appendix page(s).....	30

**REAL PARTY IN INTEREST**

The real party in interest in this Appeal is the assignee of the full right, title and interest in this Application, Shuffle Master, Inc., having a place of business at 1106 Palms Airport Drive, Las Vegas, Nevada 89119-3730.

**RELATED APPEALS AND INTERFERENCES**

The Appellant(s), the legal representative prosecuting this application and Appeal, and the assignee are not aware of any Appeals or Interferences that will directly affect or have a bearing on the Board's of Patent Appeals and Interferences decision in this pending Appeal.

**BRIEF ON APPEAL**

Serial Number: 10/ 658,863

Filing Date: September 9, 2003

Title: BET WITHDRAL GAME WITH CARD POKER SIDE BET

---

Page 5 of 31

Docket No.: PA0906.ap.US

**STATUS OF CLAIMS**

Claims 1-28, all of the claims in this Application have been finally rejected under 35 USC 102(b) and/or under 35 USC 103(a).

### **STATUS OF AMENDMENTS**

An Amendment filed under 37 CFR 1.116 after the final rejection, deleting a single duplicated word in claim 1 has not been entered as it was asserted that the correction raised new issues requiring additional searching and consideration. That minor typographic error, which is not the basis of a rejection, will be corrected upon allowance of claim 1.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

A method of playing a casino-type wagering game comprises a series of steps:

A player places an initial multiple-part wager to participate in a first poker-type game;

The player optionally places a side bet wager to participate in a second poker-type game played against a pay table;

A partial hand is dealt to the player for the first poker-type game consisting of multiple cards to each player who placed the initial wager, the partial hand for the first poker-type game being a complete hand for the second poker-type game;

Community cards are dealt to complete partial hands in the first poker-type game;  
and

Each player's initial multiple part wager is resolved according to the rules of the first poker-type game and the second poker-type wager is resolved according to a predetermined hierarchy of poker hands in a pay table. (Original Claim 1)



### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Solely for the purposes of expediting this Appeal and complying with the requirements of 37 C.F.R. 1.192(c)(7), the following grouping of claims is presented. This grouping is not intended to constitute any admission on the record that claims within groups may or may not be independently asserted in subsequent litigation or that for any judicial determination other than this Appeal, the claims may or may not stand by themselves against any challenge to their validity or enforceability.

1. Claims 1, 2, 6, 8-11, 15, 18-21, and 24-28 Have Been Rejected under 35 USC 102(b) As Anticipated by, or in the Alternative, Unobvious over de Keller (U.S. Patent No. 5,975,529)
2. Claims 22 and 23 Have Been Rejected Under 35 USC 103(a) As Unobvious over de Keller.
3. Claims 3-5, 7, 12-14, 16 and 17 Have Been Rejected Under 35 USC 103(a) As Unobvious over de Keller and Further in View of Breeding (specific Breeding Patent ambiguously cited).

## **ARGUMENT**

1. Claims 1, 2, 6, 8-11, 15, 18-21, 24 and 25 Have Been Rejected under 35 USC 102(b) As Anticipated by, or in the Alternative, Unobvious over de Keller (U.S. Patent No. 5,975,529)

The rejection is in error for at least the following two distinct reasons. First, the references cited in the rejection fail on a substantive basis to anticipate or teach the invention as claimed.

Secondly, the primary reference, deKeller, has been antedated as a reference by the claim for priority under 35 USC 120.

### **Direct Traversal of the Substantive Content of the rejection**

<b>RECITATION OF CLAIM 1</b>	<b>TEACHINGS OF deKELLER (5,975,529)</b>
A method of playing a wagering game, comprising:	A method of playing a card game comprising the steps of: requiring each player to place a first wager to participate in a wagering game played against the house/bank; <b>(Claim 1)</b>
placing a first multiple part wager to participate in a first poker-type game;	requiring each player to place a first wager to participate in a wagering game played against the house/bank;... the winner of the pot bets being the player holding the highest poker hand of five cards;...” <b>(Claim 1)</b>
optionally placing a side bet wager to participate in a second poker-type game played against a pay table;	“In Showdown Poker the object of the game is twofold: a) to make a good poker hand and b) to win the Pot bets. In the case of `a` the house payout schedule lists a series of poker rankings with

	corresponding pay-offs..." (Col. 2, lines 45-52)
dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed a first wager, <b><u>the partial hand for the first poker-type game being a complete hand for the second poker-type game;</u></b>	<b>As noted above, the play of deKeller is</b> "In Showdown Poker the object of the game is twofold: 1) to make a good poker hand using two cards and the three community cards." (Col. 4, lines 8-11) <b>There is no payable for the partial hand – only the complete hand of 5-cards.</b>
providing community cards to complete partial hands in the first poker-type game; and	"...1) to make a good poker hand using two cards and the three community cards." (Col. 4, lines 10-11)
resolving each player's multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.	"In Showdown Poker the object of the game is twofold: a) to make a good poker hand and b) to win the Pot bets. In the case of 'a' the house payout schedule lists a series of poker rankings with corresponding pay-offs and in the case of 'b' the player with the highest poker hand showing wins the Pot bets. FIG. 2. The Pot bet is a bet solely between the players. It is not a wager played against the house." (Col. 2, lines 45-53)

As can be seen in the fourth comparison box in the table above, deKeller uses five card hands both for a payable event and the Pot play event. This is in contrast to claim 1 on Appeal reciting that

**"..., the partial hand for the first poker-type game being a complete hand for the second poker-type game;"**

There is absolutely no basis for asserting that deKeller anticipates this limitation. There is also no basis in the rejection or inherently in the deKeller reference for asserting that it is obvious to fundamentally alter the play format of the deKeller game, without direction and without motivation, to make the clear differences between the claims on Appeal and the teachings of deKeller.

Both games of deKeller are played with a single hand including community cards, while the claimed invention plays a first game with each player's partial hand, and only after receiving the community cards is the game against the payable played. Those are significant and fundamental differences recited in claim 1 that establish novelty and unobviousness over the teachings of deKeller.

**CLAIM 26 WILL BE DISCUSSED OUT OF ORDER FROM INDEPENDENT  
CLAIM 18 BECAUSE OF THE NEAR IDENTITY OF ISSUES WITH THE  
ARGUMENTS OF CLAIM 1**

<b>CLAIM 26</b>	<b>deKELLER</b>
26. (PREVIOUSLY PRESENTED) A method of playing a wagering game against only pay tables, comprising:	A method of playing a card game comprising the steps of: requiring each player to place a first wager to participate in a wagering game played against the house/bank; <b>(Claim 1)</b>
placing an initial multiple part wager to participate in a first poker-type game against only a pay table;	requiring each player to place a first wager to participate in a wagering game played against the house/bank;... the winner of the pot bets being the player holding the highest poker hand of five cards;..." <b>(Claim 1)</b>
optionally placing a side bet wager to participate in a second poker-type game played against a pay table;	"In Showdown Poker the object of the game is twofold: a) to make a good poker hand and b) to win the Pot bets. In the case of 'a' the house payout schedule lists a series of poker rankings with corresponding pay-offs..." <b>(Col. 2, lines 45-50)</b>
dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed the initial multiple part wager, <b><u>the partial hand for the first</u></b>	<b>As noted above, the play of deKeller is</b> "In Showdown Poker the object of the game is twofold: 1) to make a good poker hand using two cards and the three community cards." <b>(Col. 4, lines 8-11)</b>

<b><u>poker-type game being a complete hand for the second poker-type game;</u></b>	<b>There is no payable for the partial hand – only the complete hand of 5-cards.</b>
providing community cards to complete partial hands in the first poker-type game; and	“...1) to make a good poker hand using two cards and the three community cards.” (Col. 4, lines 10-11)
resolving each player's initial multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.	“In Showdown Poker the object of the game is twofold: a) to make a good poker hand and b) to win the Pot bets. In the case of `a` the house payout schedule lists a series of poker rankings with corresponding pay-offs and in the case of `b` the player with the highest poker hand showing wins the Pot bets. FIG. 2. The Pot bet is a bet solely between the players. It is not a wager played against the house.” (Col. 2, lines 45-53)

As can be seen, claim 26 clearly recites the fact that the second wager is based upon only the partial hand cards and a ranking of the partial hand cards **ONLY**. This feature is clearly not shown by deKeller and therefore is not anticipated or obvious from the teachings of deKeller.

#### **Additional and Separate Arguments on the Merits with Respect to Claims**

New Claim 26 reads (with **highlighted** changes from claim 1 emphasized):

26. A method of playing a wagering game **against only pay tables**, comprising:  
placing a first multiple part wager to participate in a first poker-type game **against only a pay table**;  
optionally placing a side bet wager to participate in a second poker-type game played against a pay table;

dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed a first **multiple part** wager, the partial hand for the first poker-type game being a complete hand for the second poker-type game;

providing community cards to complete partial hands in the first poker-type game; and

resolving each player's multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.

deKeller clearly requires that the "pot bet" is played against other players. This does not anticipate claim 36, nor is claim 26 obvious from that teaching. deKeller has a pot bet, with separate contributions to the pot, which is won in a player-versus-player competition.

**Separate and Individual Arguments on the Merits as to Why de Keller Does Not Anticipate Claim 1 and claims dependent therefrom.**

It is asserted in the Rejection that de Keller shows, with respect to original claim 1:

- 1) multiple part wagers (All players make bets of equal value in their respective pots, then place Bet 1 (Col. 2, lines 54-64, and Fig. 1, elements 5, 6 and 7);
- 2) An optional side bet bonus wager (Col. 5, lines 8-21);
- 3) At the beginning of each hand, each player is dealt two cards, although this number may vary, one face up and two down. (Col. 2, lines 58-63). Asserting that three cards as partial hands are obvious;
- 4) The three dealer's cards are community cards completing each player's hands (Col. 2, lines 63-66);
- 5) The first multi-part wager is resolved according to the rules of 5-card poker (Col. 4, lines 39-44) with a 5-card poker pay table (Col. 4, lines 53-56);
- 6) The optional side wager is resolved according to 3-card poker (Col. 5, lines 9-21); and
- 7) Each part of the wager is equal (Col. 2, lines 58-60).

Although de Keller may arguably be interpreted to hint at some of the above teachings, it requires a strained interpretation to argue that de Keller teaches the claimed invention. The actual game taught by de Keller includes numerous distinguishable requirements and elements that can not be disregarded when comparing the teachings of de Keller with the presently claimed invention. For example, one important failure of de Keller under 35 USC 102(b) is the fact that de Keller does not place initial multiple part wagers. Applicants emphasize that limitation to indicate by “initial” that these multiple part wagers are placed prior to the player viewing dealt cards. On this basis alone, every rejection under 35 USC 102(b) is in error, and there has been no showing of this limitation sufficient to teach modification of that limitation under 35 USC 103(a). The rejections are therefore in error.

Note also that claim 26 recites wherein the game has been limited to play against only pay tables. This provides a clear avoidance of de Keller who has competition against a pay table **and** player-versus-player. It also would not be obvious to eliminate the fundamental requirements of de Keller’s game in which the multi-part wagers are required only because of the additional elements of the game.

Claim 27 focuses on the fact that the multi-part wagers are part of the same game and are resolved according to a single event in a single game. This strongly differentiates the subject matter of de Keller where there is a single wager against a table and a second pot game.

**It is asserted in the rejection** that de Keller in view of Breeding teaches the limits of claims including “...withdrawal of a part of the multiple part wager before a first community card is disclosed to the player, with the player remaining in play in the first poker-type game...” This issue may be more complex, for a number of reasons. Having distinguished de Keller for lacking multi-part wagers on the same game and playing against only a pay table, Breeding teachings both of those elements, in addition to bet withdrawal.

RECITATION OF CLAIM 18	DeKELLER
A method of playing a live casino table card game with physical cards comprising:	A method of playing a card game comprising the steps of: requiring each player to place a first wager to participate in a wagering game played against the house/bank; <b>(Claim 1)</b>
placing an initial a multiple part wager to participate in a casino wagering first poker game against a pay table in which a partial hand of at least two cards is first dealt and later completed for each player;	requiring each player to place a first wager to participate in a wagering game played against the house/bank;... the winner of the pot bets being the player holding the highest poker hand of five cards;...” <b>(Claim 1)</b>
<u>placing an optional single part wager to play a second poker-type game against a pay table using all cards in each player’s partial hand;</u>	“In Showdown Poker the object of the game is twofold: a) to make a good poker hand and b) to win the Pot bets. In the case of `a` the house payout schedule lists a series of poker rankings with corresponding pay-offs...” <b>(Col. 2, lines 45-50)</b>
dealing a partial hand of cards to each player;	<b>This step in deKeller is performed before the second game and does not require using all cards in the partial hand.</b>
providing additional cards to complete each player’s hand; and	“...1) to make a good poker hand using two cards and the three community cards.” <b>(Col. 4, lines 10-11)</b>
resolving each player's wagers in the first poker game and the second poker-type game against two different pay tables.	“In Showdown Poker the object of the game is twofold: a) to make a good poker hand and b) to win the Pot bets. In the case of `a` the house payout schedule lists a series of poker rankings with corresponding pay-offs and in the case of `b` the player with the highest poker hand showing wins the Pot bets. FIG. 2. The Pot



	bet is a bet solely between the players. It is not a wager played against the house.” (Col. 2, lines 45-53)
--	--

deKeller neither teaches nor suggests the **highlighted** limitation in claim 18, among other things. deKeller has wagers for complete (e.g., best 5 of seven cards) and does not teach the limitation of “**placing an optional single part wager to play a second poker-type game against a pay table using all cards in each player’s partial hand;**” As such, the rejection is in error and must be withdrawn.

**ESTABLISHMENT OF RIGHT TO PRIORITY UNDER 35 USC 120.**

**Argument against the Examiner’s Position That the Present Claims Lack Priority under 35 USC 120 for the Claimed Subject Matter.**

The priority claim in this Application establishes conceptual priority under 35 USC 120 for all limitations in the claims and antedates the available reference date of deKeller. The rejection therefore must fail as a matter of Law.

The sole basis for asserting that the claimed subject matter lacks priority under 35 USC 120 is that an intermediate application 08/504,023 lacks compliance with 35 USC 112, second and first paragraphs with respect to the use of “community cards” because the rejection asserts:

- 1) the application teaches a single Wild Card that is used by all players; and

- 2) Wild Cards are not community cards because they are different values to each player.

The analysis of this issue of the effect of the Wild Card is in error. Community cards are card(s) common to every player at the table. The type, nature and use of that card are not fundamental to whether or not it is a community card or other cards are discarded or not. For illustrative purposes, it should be noted that the same community card, whether it is a Wild Card or not, may be used in the same round of a game to form various hands of differing values to one or more players, depending on the hole cards (*i.e.*, the cards which are **not** community cards) held in each player's hand. To show that this is common knowledge to one skilled in the art, Applicant cites the following knowledge in the public domain:

- 1) *Ainslie's Complete Hoyle*, Ton Ainslie, Fireside Book, Simon & Schuster, New York, 1975, pp. 268-269; and
- 2) [www.Pogo.com](http://www.Pogo.com), online wagering at Club Pogo, Texas Hold'Em, Jokers Wild.

The first reference (Ainslie) is self-explanatory. It shows that in at least one commonly known poker game, Wild Widow, a single center card (as in Let It Ride® poker taught in the 08/504,023 application) is a wild card for every player, to be used in combination, as the individual players desire, with the other cards dealt to the players. Ainslie therefore shows that a single center wild card is a community card.

The Club Pogo site, which has been in place for at least 5 years, provides an on-line game room in which Texas Hold'Em poker and its variants are played. As is well known, Texas Hold'Em is played with each player receiving two Hold Cards (pocket cards) and in staged events, five community cards. Club Pogo's site includes a variant of Texas Hold'Em called Jokers Wild. In this game, the standard 52-card deck is replaced with a 54-card deck having exactly two Jokers. Each Joker is wild. When one or more Jokers appears in the flop, 4<sup>th</sup> street or the River Card, each player uses each Joker in a manner to make the player's hand the highest possible rank. The Flop, 4<sup>th</sup> street and the River Card constitute the totality of community cards used in the game. Again, this establishes that the use of a Wild card in a community card set may be used by each player in any way that individual player wants to make the player's hand the best possible rank, independent of the suit or rank that Wild card is used by any other player. The use of the Wild card in the community card set consisting of the Flop, 4<sup>th</sup> street and the River Card clearly establishes that the Wild card is still a community card.

It is clear that the teaching of a wild card in U.S. Patent Application No. 08/504,023 does not cause a failure in the stream of priority as asserted by the Final Office Action. To that end, as clearly indicated below, the claim for priority has been shown to meet the requirements of 35 USC 112, first and second paragraphs with regard to the single ground of objection proposed in the Final Office Action. With the following described priority chain being satisfactory, deKeller is not available as a reference, even

if it provided an effective teaching against the claims, which it does not, as clearly shown above.

It therefore believed that the de Keller reference is not available under 35 USC 102(b) as a reference in view of the priority date chain established for the present application. In this regard, the Examiner is requested to review the Table below showing priority for the concepts in the limitations in the claims from the earliest application in the priority chain, which application antedates the filing date of the de Keller reference.

RECITATION OF CLAIM 1	PRIORITY LANGUAGE IN U.S. PATENT NO. 5,685,774
A method of playing a wagering game, comprising:	"Card-type games provide at least one player with the option of wagering against either a predetermined payout schedule, a dealer's hand, or both." (Abstract)
Placing a first multiple part wager to participate in a first poker-type game;	"(a) determining whether to place a first bet that the player's hand will be greater than a first predetermined rank, where a plurality of hands are ranked according to predetermined rules and the first bet is a fixed payout bet;" (Claim 1) "A method of playing a card game according to claim 23 wherein said card deck is a conventional card deck comprising at least fifty-two cards, and each hand comprises four cards and each player combines said wild card indicia with four indicia of playing cards to form a five card poker hand." (Claim 24)
optionally placing a side bet wager to participate in a second poker-type game played against a pay table;	"(a) determining whether to place a first bet that the player's hand will be greater than a first predetermined rank, where a plurality of hands are ranked according to predetermined rules and the first bet is a

	fixed payout bet;" (Claim 1) and "(b) determining whether to place a second bet that the player's hand will beat the dealer;" (Claim 1)
Dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed a first wager, the partial hand for the first poker-type game being a complete hand for the second poker-type game;	"The card of FIGS. 4-6 has a dual function; in playing the game it is used as a wild card; subsequently the card can be taken away by the player and retained as a momento and also serves as a promotional item. In a three-card version of the game described above, a player may be provided with two standard cards and a wild card to form a three-card hand. Alternatively, at least one player may be provided with three cards and be permitted to discard one card in order to form his/her best three-card hand using the wild card. Similarly, in four and five-card versions of the game a wild card of the kind shown in FIGS. 4-6 may be issued to each player and to the dealer. The players and dealer then use the wild card repeatedly in conjunction with each four card hand dealt to them to make a five-card poker hand. In a five-card game each player and the dealer may substitute the wild card for any card in their hand to improve the five-card hand they hold. This has the result of creating higher hand values and adding excitement to the game. According to each of these embodiments, the dealer is also preferably provided with the same number of standard cards and a wild card as provided to each player." <b>The additional card indicates that the original hand is only a partial hand.</b>
providing community cards to complete partial hands in the first poker-type game; and	"According to each of these embodiments, the dealer is also preferably provided with the same number of standard cards and a wild card as provided to each player." <b>The single wild card to all players is a</b>

resolving each player's multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.	<b>community card.</b> “if the dealer's hand does not exceed the second predetermined rank, the bank paying each player an amount based on the second bet and returning the third bet to the player, or if the dealer's hand exceeds the second predetermined rank, comparing the dealer's hand in turn with that of each other player who placed the second bet and if the player's hand is higher, the banker paying the player an amount based on both the second and third bets, and if the player's hand is lower, the player forfeiting both the second and third bets to the banker; and (g) the banker paying the fixed payout bet in accordance with a predetermined scale to any player who placed the first bet and whose hand exceeds the first predetermined rank.” (Claim 1)
---	---

As can be seen, the concept of Claim 1 of the present application finds antecedent basis in parent application 08/504,023 and issued patent U.S. Patent No. 5,685,774 issued November 11, 1997, **which was filed on July 19, 1995**. That filing date provides a date prior in time to the available reference date of the de Keller reference, which is that patent's filing date of **September 11, 1995**. The de Keller reference is therefore not available as a reference under 35 USC 102(b) as it is not prior to the established priority date of the present application and claims.

Note that the original specification of this Application as filed stated and claimed priority as:

“This application is a continuation-in-part of U.S. Patent Application Serial No. 10/016,436, filed April 29, 2002, titled Player Banked Three Card Poker and Associated Games, which in turn is a continuation-in-part of U.S. Patent Application Serial No. 09/249,118 filed February 2, 1999 which in turn is a continuation-in-part of U.S. Patent Application Serial No. 09/170,092 filed October 13, 1998, now U.S. Patent No.

6,237,916 issued May 29, 2001, which is a continuation-in-part of U.S. Patent Application Serial No. 08/889,919 filed July 10, 1997 now U.S. Patent No. 6,056,641 issued May 2, 2000, which is a division of U.S. Patent Application Serial No. 08/504,023 filed July 19, 1995, now U.S. Patent No. 5,685,774 issued November 11, 1997.”

This priority date is established and is effective in overcoming the de Keller reference.

2. Claims 22 and 23 Have Been Rejected Under 35 USC 103(a) As Unobvious over de Keller.

As the de Keller reference has been shown to be unavailable as a matter of law as a “prior art” reference under 35 USC 102(b), this rejection must fail for at least the same reasons described directly above.

Additionally, as deKeller has been shown to fail in its teaching of the limitations in the independent claims, and as there is nothing further in this rejection to correct those deficiencies, this rejection must also fail on a substantive basis as well as a matter of Law as not being a prior document under 35 USC 102.

3. Claims 3-5, 7, 12-14, 16 and 17 Have Been Rejected Under 35 USC 103(a) As Unobvious over de Keller and Further in View of Breeding (specific Breeding Patent ambiguously cited).

As the de Keller reference has been shown to be unavailable as a matter of law as a “prior art” reference under 35 USC 102(b), this rejection must fail for at least the same reasons described directly above.

---

Additionally, as deKeller has been shown to fail in its teaching of the limitations in the independent claims, and as there is nothing further in this rejection to correct those deficiencies, this rejection must also fail on a substantive basis as well as a matter of Law as not being a prior document under 35 USC 102.



## CONCLUSION

All rejections of record have been shown in detail to be in error. The rejection should be reversed and all claims should be indicated as allowable.


Applicants believe the claims are in condition for allowance and request reconsideration of the application and allowance of the claims. The Examiner is invited to telephone the below-signed attorney at 952-832-9090 to discuss any questions that may remain with respect to the present application.

Respectfully submitted,  
INVENTOR NAMES

By their Representatives,  
MARK A. LITMAN & ASSOCIATES, P.A.  
York Business Center, Suite 205  
3209 West 76<sup>th</sup> Street  
Edina, MN 55435  
(952)832.9090

Date *16 February 2006*

By

  
Mark A. Litman  
Reg. No. 26,390

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Box: APPEAL BRIEF - PATENTS, P.O. BOX 1450; Commissioner for Patents, Alexandria, VA 22313-1450 on FEBRUARY *16*, 2006.

Name: Mark A. Litman

  
Signature

## CLAIMS APPENDIX

1. (PREVIOUSLY PRESENTED) A method of playing a wagering game, comprising:
  - placing an initial multiple-part wager to participate in a first poker-type game;
  - optionally placing a side bet wager to participate in a second poker-type game played against a pay table;
  - dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed the initial wager, the partial hand for the first poker-type game being a complete hand for the second poker-type game;
  - providing community cards to complete partial hands in the first poker-type game; and
  - resolving each player's initial multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.
2. (ORIGINAL) The method of claim 1 wherein a payout is made to the player on the side bet wager in the second poker-type game for one of a plurality of predetermined winning outcomes.
3. (PREVIOUSLY PRESENTED) The method of claim 2 wherein the rules of the first poker-type game allow at least partial withdrawal of a part of the initial multiple part wager before a first community card is disclosed to the player, with the player remaining in play in the first poker-type game.
4. (ORIGINAL) The method of claim 3 wherein the partial hand is exactly three cards, and a complete hand in the first poker-type game is five cards.

5. (PREVIOUSLY PRESENTED) The method of claim 4 wherein the first part multiple wager and the side bet wager are resolved according to a first pay table on the initial multiple part wager and a second pay table on the optional side bet wager.
6. (ORIGINAL) The method of claim 1 wherein the player is dealt a three-card partial hand, there are two community cards, and the optional side bet wager is against a pay table for three-card poker.
7. (ORIGINAL) The method of claim 6 wherein the player must make at least the initial multiple part wager a three-part multiple part wager, the two community cards are placed face down, and the player may remove one part of the at least three part wager before each community card is revealed from a face down position.
8. (ORIGINAL) The method of claim 6 wherein the game is a casino table card game.
9. (ORIGINAL) The method of claim 6 wherein the game is an electronic video wagering game.
10. (ORIGINAL) The method of claim 1 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.
11. (ORIGINAL) The method of claim 2 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.
12. (ORIGINAL) The method of claim 3 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.

13. (ORIGINAL) The method of claim 4 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.

14. (ORIGINAL) The method of claim 5 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.

15. (ORIGINAL) The method of claim 6 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.

16. (ORIGINAL) The method of claim 7 wherein each part of the multiple-part wager must be equal to other parts of the multiple-part wager.

17. (ORIGINAL) The method of claim 6 wherein community cards are revealed one community card at a time, and each player is given an opportunity to withdraw one part of the multiple part wager before each community card is revealed.

18. (PREVIOUSLY PRESENTED) A method of playing a live casino table card game with physical cards comprising:

- placing an initial a multiple part wager to participate in a casino wagering first poker game against a pay table in which a partial hand of at least two cards is first dealt and later completed for each player;

- placing an optional single part wager to play a second poker-type game against a pay table using all cards in each player's partial hand;

- dealing a partial hand of cards to each player;

- providing additional cards to complete each player's hand; and

- resolving each player's wagers in the first poker game and the second poker-type game against two different pay tables.

19. (ORIGINAL) The method of claim 16 wherein at least some payouts proportional to the optional single part wager are available in resolving hands for obtaining a predetermined rank of a hand.

20. (PREVIOUSLY PRESENTED) The method of claim 16 comprising placing a three part wager as the initial multiple part wager in the first poker game and receiving three cards as the partial hand.

21. (ORIGINAL) The method of claim 18 wherein the partial hand of a player is completed with at least two community cards.

22. (ORIGINAL) The method of claim 19 wherein proportional payouts for the optional side bet wager include possible payouts of between at least 1 to 1 and 100 to 1 against the optional single part wager.

23. (ORIGINAL) The method of claim 20 wherein the proportional payouts include at least two possible payouts of at least 10 to 1.

24. (ORIGINAL) The method of claim 18 where community cards are provided.

25. (ORIGINAL) The method of claim 18 where additional cards are dealt to each hand.

26. (PREVIOUSLY PRESENTED) A method of playing a wagering game against only pay tables, comprising:

placing an initial multiple part wager to participate in a first poker-type game against only a pay table;

optionally placing a side bet wager to participate in a second poker-type game played against a pay table;

dealing a partial hand for the first poker-type game consisting of multiple cards to each player who placed the initial multiple part wager, the partial hand for the first poker-type game being a complete hand for the second poker-type game;

providing community cards to complete partial hands in the first poker-type game; and

resolving each player's initial multiple part wager according to the rules of the first poker-type game and resolving the second poker-type wager according to a predetermined hierarchy of poker hands in a pay table.

27. (PREVIOUSLY PRESENTED) The method of claim 26 wherein wagers in the first poker-type game and wagers in the second poker-type game are resolved at the same time after completion of the partial hand.

28. (PREVIOUSLY PRESENTED) The method of claim 26 wherein wagers in the first poker-type game and wagers in the second poker-type game are resolved at separate times, with the wager in the second poker-type hand resolved after completion of the partial hand.

## **EVIDENCE APPENDIX**

There is no extrinsic evidence, declarations or affidavits that have been submitted that have a material bearing on this Appeal, except for the claim to priority under 35 USC 120 made in the Application and Declaration, which priority claim has been granted.

**BRIEF ON APPEAL**

Serial Number: 10/ 658,863

Filing Date: September 9, 2003

Title: BET WITHDRAL GAME WITH CARD POKER SIDE BET

---

Page 31 of 31

Docket No.: PA0906.ap.US

**RELATED PROCEEDINGS APPENDIX**

There are no related proceedings known to Appellants or their counsel in courts, the Patents and Trademark Office or any other legal venue having any bearing on the issues in this Appeal.